

REMARKS

In the instant Action, Claims 3-13 are listed as pending, Claims 3-7 and 13 are listed as rejected, and Claims 8-12 are listed as objected to.

However, Applicant respectfully contends that the “method” Claims 14-28 should also be listed as pending, as Applicant did not cancel these claims at any time during prosecution. In fact, in the previous Office Action, which was mailed 03/05/2009, Claims 14-28 were listed as pending and also withdrawn from consideration. At page 7 of the instant Action, the Examiner states “Applicant contends that only the ‘compound’ claims are being examined on the merits, not the ‘method’ claims,” which perhaps hints that the Examiner might have thought that Applicant intended to cancel Claims 14-28. Contrary to the Examiner’s misplaced belief, Applicant never intended to cancel Claims 14-28. In fact, in reply to the previous Office Action, Applicant wrote, at page 25, “grant of the requested rejoinder and examination on the merits of Claims 14-28 drawn to the nonelected method of use invention ... [is] respectfully requested.”

Applicant’s contention is consistent with the previous Office Action wherein Claims 14-18 are listed as pending and merely withdrawn from consideration. Further consistent therewith, in Applicant’s reply to the previous Office Action, the status of Claims 14-28 is indicated as “Withdrawn.” Further consistent therewith, Applicant respectfully direct the Examiner’s attention to MPEP § 821, which provides:

... The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 821 through § 821.03. However, if applicant elects a claim(s) directed to a product which is subsequently found allowable, withdrawn process claims which depend from or otherwise require all the limitations of an allowable product claim will be considered for rejoinder. ... (emphasis added)

It is very puzzling to Applicant how the “withdrawn” Claims 14-18 are no longer pending in the application. Applicant respectfully insists that the Examiner consider Claims 14-18 for rejoinder as required under 37 CFR 1.142.

MPEP § 821 also provides that:

... Process claims which depend from or otherwise require all the limitations of the patentable product will depend from or otherwise require all the limitations of the

patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. ... (emphasis added)

Since the instant Action *non-final*, and since Claims 14-28 are being amended to depend from Claims 8-12 which the Examiner states in the instant Action as would be allowable if re-written in independent form, Applicant respectfully contends that the Claims 14-18, as presently being amended, should be entered as a matter of right.

- Applicant's response to claim objections

The Examiner indicates that Claims 8-12 are objected to for depending upon a rejected claim, but would be allowable if re-written in independent form. Applicant has fully complied with this requirement, and therefore, respectfully requests allowance of Claims 8-12.

- Applicant's response to claim rejections under 35 USC § 112, written description

The Examiner has rejected Claims 1-7 and 13 under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. Without acquiescing to the Examiner's allegations, but solely in order to place the present application in a condition for allowance, Applicant has canceled Claims 1-7.¹

However, Applicant respectfully points out that Claim 13, which is directed to "pharmaceutical composition comprising a compound according to [now allowable Claims 8-12]", is outside the scope of the Examiner's discussions of why the Examiner feels that the genus of formula I is not adequately described in the specification. For instance, at page 4 of the instant Action, the Examiner states:

One of skill in the art would not recognize from the disclosure that the applicant was in possession of the genus of which comprises the compound of the formula I: (R2,R3) A3-A4-A5-A6-A7-A8-A9-A10-A11-A12-A13-A14-A15-A16-A17-A18-A19-A20-A21-A22-A23-A24-A25-A26-A27-A28-A29-A30-A31-A32-A33-A34-A35-A36-R1.

¹ Applicant had already canceled Claims 1 and 2 in reply to the previous Office Action.

Applicant believes that the Examiner simply overlooked the fact that Claim 13 has nothing to do with the written description requirement for a claimed genus. As such, Applicant respectfully requests reconsideration and withdrawal of this rejection.

- Applicant's response to claim rejections under 35 USC § 112, enablement

The Examiner has rejected Claims 1-7 and 13 under 35 USC § 112, first paragraph, as failing to provide enablement for a compound of the formula I. Without acquiescing to the Examiner's allegations, but solely in order to place the present application in a condition for allowance, Applicant has canceled Claims 1-7.²

However, as noted above, Claim 13 is directed to "pharmaceutical composition comprising a compound according to [now allowable Claims 8-12]", which is outside the scope of the Examiner's discussions of why the Examiner feels that the genus of formula I is not adequately supported by the specification. For instance, at page 7 of the instant Action, the Examiner states:

The claimed invention is drawn to a compound of formula I : (R2,R3)

A3-A4-A5-A6-A7-A8-A9-A10-A11-A12-A13-A14-A15-A16-A17-A18-A19-A20-A21-
A22-A23-A24-A25-A26-A27-A28-A29-A30-A31-A32-A33-A34-A35-A36-R1.

Applicant believes that the Examiner simply overlooked the fact that Claim 13 has nothing to do with the enablement requirement for a claimed genus. As such, Applicant respectfully requests reconsideration and withdrawal of this rejection.

In conclusion, reconsideration of the instant Action, entry of the requested amendments, grant of the requested rejoinder and examination on the merits of Claims 14-28 drawn to the nonelected method of use invention, and allowance of all pending claims are respectfully requested.

Prompt and favorable action is solicited.

Examiner Telleris invited to telephone Applicant's undersigned if deemed necessary to facilitate prosecution of this application.

² Applicant had already canceled Claims 1 and 2 in reply to the previous Office Action.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'Tony K. Uhm', written over a horizontal line.

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